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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,093	11/16/2001	Roland R. Thompson	FLD0001-CIP2	8060

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KILPATRICK STOCKTON LLP  
607 14TH STREET, N.W.  
WASHINGTON, DC 20005

EXAMINER
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TARAE, CATHERINE MICHELLE

ART UNIT	PAPER NUMBER
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3623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/683,093

Applicant(s)

THOMPSON ET AL.

Examiner

C. Michelle Tarae

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16, 21-23, 25-42, 44-53 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16, 21-23, 25-42, 44-53 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a Final Office Action in response to the communication received on January 24, 2007. Claims 9, 12, 21 and 25 have been amended. Claims 43 and 54 have been cancelled. Claims 9-16, 21-23, 25-42, 44-53 and 55 are now pending in this application.

#### ***Response to Amendments***

2. Applicant's amendments to claims 9, 12, 21 and 25 and cancellation of claims 43 and 54 are acknowledged.

#### ***Response to Arguments***

3. Applicant's arguments have been fully considered and are found persuasive. In the Remarks, Applicant argues that Subfinder does not teach the newly added limitation indicating that the absentee list is received from an authorized individual associated with a first organization, wherein the authorized individual is a worker other than one of the absent workers.

In response to the argument and the newly added limitation to claims 9, 12, 21 and 25, an updated rejection is provided below.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 22, 23, 26-42, 44-53 and 55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 6 of U.S. Patent No. 6,675,151. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 22, 23, 26-28, 32 and 36 each contain obvious modifications to claims 3 or 6 of U.S. Patent No. 6,675,151.

As per claims 22, 23, 26-28, 32 and 36 of the instant application, the claims do not recite first receiving absentee information representing absent workers as recited in claims 3 and 6 of U.S. Patent No. 6,675,151, thus making claims 22, 23, 26-28, 32 and 36 broader. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to omit the step of receiving absentee information if the step was not desired or required as part of the overall invention. See MPEP 2144.04, II, A.

Additionally, as per claim 23 of the instant application, the claim replaces the word, Internet, in claim 3 of U.S. Patent No. 6,675,151 for the phrase, instant

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messaging. It is old and well known in the art that instant messaging is a type of communication able to be performed over a network such as the Internet. Thus, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace Internet for instant messaging as doing so covers a particular type of communication that uses Internet technology, thus expanding the application of the instant invention.

Additionally, as per claim 27 of the instant application, the claim recites a computer readable medium that essentially performs the steps recited in claim 3 of U.S. Patent No. 6,675,151. At the time of the invention, it would have been obvious to recite a computer readable medium that performs the steps of a claimed method since doing so simply covers another statutory class.

As per claims 37, 44, 45, 46, 50 and 55 of the instant application, the claims recite similar language as recited in claims 3 and 6 of U.S. Patent No. 6,675,151. However, in claims 37, 44, 45, 46, 50 and 55 of the instant application, the use of the phrases "first worker" and "second worker" are used in place of the phrases "absent worker" and "substitute worker" as recited in claims 3 and 6 of U.S. Patent No. 6,675,151. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the phrases "absent worker" and "substitute worker" with "first worker" and "second worker," respectively, as doing so broadens the scope of the type of worker.

Additionally, as per claims 44, 45, 46, 50 and 55 of the instant application, the claims do not recite first receiving absentee information representing absent/first

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workers as recited in claims 3 and 6 of U.S. Patent No. 6,675,151, thus making claims 44, 45, 46, 50 and 55 broader. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to omit the step of receiving absentee information if the step was not desired or required as part of the overall invention. See MPEP 2144.04, II, A.

Additionally, as per claims 44, 45, 50 and 55 of the instant application, the claims recite a computer readable medium that essentially performs the steps recited in claim 3 of U.S. Patent No. 6,675,151 (minus the differences as noted above). At the time of the invention, it would have been obvious to recite a computer readable medium that performs the steps of a claimed method since doing so simply covers another statutory class.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-16, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Subfinder™ System (hereinafter, "Subfinder"). The following articles are used to explain the different aspects of the Subfinder reference:

- "Automated Substitute Finder System," from the Internet, Fall 1994 (hereinafter, reference A);

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- "Computer calls for substitutes," from *The Sun*, Dec 15, 1994 (hereinafter, reference B);
- "Telephony products enhance convenience, communication & distance learning," from *THE Journal*, Feb 1996 (hereinafter, reference C); and
- "Substitute teacher shortage hits schools," from the Internet, April 24, 1998 (hereinafter, reference D)

As per claim 9, Subfinder discloses a substitute fulfillment system that identifies and secures substitute workers for a plurality of different organizations comprising:

a database comprising worker records, said worker records having information associated with workers for each of the organizations, and substitute records, said substitute records having information associated with at least one substitute worker (reference A, paragraphs 2 and 5; reference D, paragraph 8; Subfinder utilizes a database that contains worker records where the workers are teachers and the worker records include teacher availability, teacher skills and teacher preferences. The teachers are associated with various schools within school districts.);

a server coupled to the database, the server is configured for:

receiving absentee information of one or more absent workers via at least one communication link coupled to the server (reference A, paragraphs 2 and 9; reference B, paragraph 1; Teachers call into the system and record their absences. Subfinder also discloses its SubFax option in which status reports are automatically broadcast to individual sites daily.);

generating in response to receiving the absentee list one or more lists of one or more potential substitute workers who can fill in for each absent worker on the absentee list using the worker records associated with the absent worker and the substitute records (reference A, paragraph 2; reference B, paragraph 1; For each absent teacher, a list of qualified substitute teachers is generated and each substitute teacher is contacted to fill in for the absent teacher.); and

contacting potential substitute workers listed on each of the generated lists until one of the substitute workers in each of the generated lists agrees to fill in for the absent worker or until all of the generated lists are exhausted (reference A, paragraph 2; reference B, paragraphs 1 and 3; The system automatically contacts substitute teachers on the lists until the absent teacher position is filled or until the system has contacted everyone on the lists.).

Subfinder does not expressly disclose receiving an absentee *list* from an *authorized individual associated with a first organization, wherein the authorized individual is a worker other than one of the absent workers*. Rather, Subfinder teaches automating the process of receiving absentee information by having the teachers (absent workers) call into the system directly to record their absence, where the system then generates absenteeism reports and automatically broadcasts the reports to the individual school sites (reference A, paragraph 9). Examiner takes Official Notice that it is old and well known to manually perform an automated process so as to ensure more control over the process such as in situations where something needs to be overridden or when a computer failure occurs and further, that an authorized individual is usually



designated to control the manual process. Examiner further takes Official Notice that lists provide an organized and convenient means to manage information. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Subfinder so that it receives an absentee *list* from an *authorized individual associated with a first organization, wherein the authorized individual is a worker other than one of the absent workers* because doing so provides the authorized individual with more control over the process of managing the absentee information, thereby ensuring that the proper and necessary absentee information is included in the list, which, in turn, ensures that the proper and necessary information is available for contacting potential substitute workers to fill in for the absent workers indicated in the absentee list.

As per claim 10, Subfinder discloses the substitute fulfillment system of claim 9 wherein each of the least one communication link is a link selected from the group consisting of a telephone communication link or an Internet communication link (reference A, paragraph 2; reference C, paragraph 6; Subfinder uses a telephone communication link to receive absentee information and to contact and secure substitute teachers for the absent positions.).

As per claim 11, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server generates the list of one or more substitute workers using a preferred list of substitute workers associated with the worker record for the absent worker (reference A, paragraph 2; reference B, paragraphs 1 and 3; reference D, paragraph 8; Subfinder generates preferred lists of substitute teachers based on criteria

such as substitute teachers the absent teacher has designated and skills/specialties/qualifications of substitute teachers.).

As per claim 12, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server is further configured to generate a list of substitute workers and names of the absent workers who the substitute workers will be filling in for at the first organization and to transmit the generated list of substitute workers and names of the absent workers who the substitute workers will be filling in for to the first organization via the at least one communication link (reference A, paragraphs 4 and 9; Principles and other administrators have the ability to call into the system to receive reports on absentee information as well as substitute teacher information. Reports can also be faxed.).

As per claim 13, Subfinder discloses the substitute fulfillment system of claim 9 further comprising an interactive voice response system controlled by the server for interacting with a potential substitute worker from the generated list of potential substitute workers via at least one telephone communication link whereby the potential substitute worker is secured for filling in for the absent worker (reference B, paragraphs 4-8; Absent and substitute teachers use a combination of voice and telephone number prompts to interact with Subfinder. Absent teachers indicate their absence and any other special messages for the substitute. Substitute teachers indicate a desire to accept or decline a job.).

As per claim 14, Subfinder discloses the substitute fulfillment system of claim 9 wherein the server is further configured to receive a message via the at least one

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communication link and to forward the received message to the substitute worker who agrees to fill in for the absent worker via the at least one communication link (reference B, paragraphs 4 and 5; Absent teachers may leave messages for substitute teachers via a telephone link.).

As per claim 15, Subfinder discloses the substitute fulfillment system of claim 9 wherein the organizations are unaffiliated (reference B, paragraph 10; Subfinder may be used across multiple school districts, which are not affiliated with each other.).

As per claim 16, Subfinder discloses the substitute fulfillment system of claim 9 wherein the workers are teachers and the substitute workers are substitute teachers (reference B, paragraph 1).

Claims 21 and 25 recite substantially similar subject matter to claim 9 above. Therefore claims 21 and 25 are rejected on the same basis as claim 9 above.

***Allowable Subject Matter***

8. Claims 22, 23, 26-42, 44-53 and 55 are allowable over the prior art of record. Claims 22, 23, 26-42, 44-53 and 55 would be allowed upon the filing and acceptance of a Terminal Disclaimer to overcome the current Double Patenting rejection.

**Conclusion**

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Tarae whose telephone number is 571-272-6727. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 571-272-6729.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



**C. MICHELLE TARAE**  
**PRIMARY EXAMINER**

April 10, 2007